

REMARKS

At the outset, Applicants thank the Examiner for the thorough review and consideration of the subject application. The Non-Final Office Action of May 11, 2004 has been received and its contents carefully reviewed.

Claims 1, 4, 6-10, 12, 14-16, 19, 30, 33, 35, 36, 38, 39, 56, 60, 64-70, 73, 75, 76, and 82 are hereby amended; claims 53, 54, 63, 80, and 81 are hereby canceled; and claims 83-85 are hereby added. Accordingly, claims 1-52, 55-62, 64-79, and 82-85 are currently pending. Reexamination and reconsideration of the pending claims is respectfully requested.

In the Office Action, the Examiner objected to the Declaration for failing to identify the citizenship of the inventors and for failing to identify to the city and state/foreign country of residence of the inventors. Applicants hereby submit a Supplemental Declaration with the missing information and respectfully request withdrawal of the present objection to the Declaration.

In the Office Action, the Examiner objected to claims 53 and 54 as respectively reciting essentially and exactly the same inventions as claims 38 and 39. Applicants hereby cancel claims 53 and 54 and respectfully submit the present objection is moot. Applicants therefore request withdrawal of the present objection to the claims.

In the Office Action, the Examiner rejected claims 12, 15, 19, 64, 66, 80, and 81 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite due to a failure to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner rejected claim 12 based on the phrase "said walls" for which there is allegedly no antecedent basis. Similarly, the Examiner rejected claims 15 and 19

based on the phrase “said optical input receptacle” for which there is allegedly no antecedent basis. Finally, the Examiner rejected claims 64, 66, 80, and 81 based on the phrases “said sheath” or “said inner conductor” for which there are allegedly no antecedent bases. Given the present amendments to claims 12, 15, 19, 64, 66, Applicants respectfully submit that the claims now more clearly recite the subject matter of the present invention and respectfully request withdrawal of the present rejection under 35 U.S.C. § 112, second paragraph. Further, Applicants submit the rejection of claims 80 and 81 is moot in view of their cancellation.

In the Office Action, the Examiner rejected claims 1, 2, 4, 6, 7, 9, 10, 23, 30, 31, 33, 35, 36, 38, 39, 47, 53, and 54 under 35 U.S.C. § 102(e) as allegedly being anticipated by Kuwahara et al. This rejection is respectfully traversed and reconsideration is requested.

Applicants respectfully submit claim 1 is patentable over Kuwahara et al. because claim 1 recites a combination of elements including, for example “a cover having a plurality of shield walls; a submount having a plurality of barriers aligned with said plurality of shield walls; a plurality of transmission line pins retained within said submount and between said plurality of barriers, wherein said plurality of transmission line pins extend from a cavity within said submount to an exterior of the optoelectronic packaging assembly.” Kuwahara et al. fails to teach, either expressly or inherently, at least these features of the claimed invention.

Claim 30 is patentable over Kuwahara et al. because claim 30 recites a combination of elements including, for example “a submount retaining a plurality of transmission line pins, each comprised of an inner conductor, a dielectric sheath, and an outer conductive shield, that extend from a cavity within said submount to an exterior of said submount, said submount further including barriers between portions of adjacent transmission line pins within said cavity,

wherein a surface of said barriers is coated with a conductive material.” Kuwahara et al. fails to teach, either expressly or inherently, at least these features of the claimed invention.

Further, in specifically rejecting claim 30, the Examiner cites Kuwahara et al. as merely teaching wherein “protruding portions 17 constitute barriers between adjacent transmission line pins.” Up until the mailing date of the present Office Action, claims 1 and 30 both recited wherein the transmission line pins were each comprised of “an inner conductor, a dielectric sheath, and an outer conductive shield” and that the transmission line pins “extend from a cavity within said submount.” In rejecting claim 1, the Examiner cites Kuwahara et al. as allegedly teaching “a submount 11 retaining a plurality of transmission line pins each including an inner conductor 14, a dielectric sheath 15, and an outer conductive shield 17.” In view of the rejections to claims 1 and 30, Applicants consequently assume the Examiner intended Kuwahara et al. to read on all elements of claim 30 in a similar manner as the elements of claim 1. Applicants respectfully submit, however, that Kuwahara et al. fails to anticipate each and every element as set forth in claim 30.

Specifically, the “transmission line pins” (14/15/17) of Kuwahara et al., as interpreted by the Examiner, do not extend from a cavity within the submount 11 to an exterior of the submount, as recited in claim 30. Rather, and as best shown in Figure 3A of Kuwahara et al., only terminals 14 extend from a cavity within the submount 11 to an exterior of the submount - not the terminals 14, glass pieces 15, and metallic protruding portions 17 as implied by the Examiner.

Further, in rejecting claim 30, the Examiner states the structure designated at reference numeral 17 serves as both outer conductive shields of each of the transmission line

pins and barriers between adjacent transmission line pins. It is respectfully submitted, however, that the structure designated at reference numeral 17 cannot logically both be the barrier between adjacent transmission line pins and the outer conductive shield of the transmission line pins.

For at least the reasons presented above, Applicants respectfully submit claim 30 is patentable over Kuwahara et al.

Applicants respectfully submit that claims 2, 4, 6, 7, 9, 10, 23, 31, 33, 35, 36, 38, 39, 47, 53, and 54 are patentable over Kuwahara et al. for at least the reason that they variously depend on claims 1 and 30.

Further, in rejecting claim 4, the Examiner states Kuwahara et al. teaches “that the package may be made from conductive plastic,” and that “[i]t is known... that conductive plastic typically is made from nonconductive plastic impregnated with conductive particles, or from nonconductive plastic which is coated with a conductive material.” The Examiner then concludes that “the conductive plastic referred by Kuwahara would in practice include nonconductive plastic.” Applicants respectfully disagree.

In view of the statements above, it appears as though the Examiner is arguing that the conductive plastic referred to in Kuwahara et al. inherently includes non-conductive plastic. To establish inherency, however, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied reference (see M.P.E.P. § 2112). Applicants respectfully submit that plastics which intrinsically conduct electricity do exist. Therefore, and

unless Kuwahara et al. states that the conductive plastic also includes intrinsically conductive plastic, it cannot be said that Kuwahara et al. anticipates the element of claim 4.

Applicants respectfully submit claims 1, 2, 4, 6, 7, 9, 10, 23, 30, 31, 33, 35, 36, 38, 39, 47, 53, and 54 are patentable over Kuwahara et al. at least for the reasons set forth above with respect to the rejection of claims 1 and 30 and request that the Examiner withdraw the present rejection of the claims under 35 U.S.C. § 102(e).

In the Office Action, the Examiner rejected claims 56, 59, 65, 73, and 74 under 35 U.S.C. § 102(b) as allegedly being anticipated by Makiuchi et al. This rejection is respectfully traversed and reconsideration is requested.

Applicants respectfully submit claim 56 is patentable over Makiuchi et al. because claim 56 recites a combination of elements including, for example “a submount; a plurality of transmission line pins extending from an interior of said submount to an exterior of said submount, a portion of at least one transmission line pin being electrically shorted to the submount.” Makiuchi et al. fails to teach, either expressly or inherently, at least these features of the claimed invention.

Applicants respectfully submit that claims 59, 65, 73, and 74 are patentable over Makiuchi et al. for at least the reason that they variously depend on claims 56. Therefore, Applicants respectfully request that the Examiner withdraw the present rejection of the claims under 35 U.S.C. § 102(b).

In the Office Action, the Examiner rejected claims 5, 11-13, 16, 34, 41-44, and 46 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kuwahara et al. This rejection is respectfully traversed and reconsideration is requested.

Claims 5, 11-13, 16, 34, 41-44, and 46 are patentable over Kuwahara et al. for at least the reason that they variously depend on claims 1 and 30. Therefore, Applicants request withdrawal of the present rejection of the claims under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 57, 58, 60-63, 68-71, 76, 77, and 82 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Makiuchi et al. This rejection is respectfully traversed and reconsideration is requested.

Claims 57, 58, 60-63, 68-71, 76, 77, and 82 are patentable over Makiuchi et al. for at least the reason that they depend on claim 56. Therefore, Applicants request withdrawal of the present rejection of the claims under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 1-3, 8-10, 17, 18, and 20-26 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hokanson et al. (U.S. Patent No. 4,873,566). This rejection is respectfully traversed and reconsideration is requested.

Applicants respectfully submit claim 1 is patentable over Hokanson et al. because claim 1 recites a combination of elements including, for example “a cover having a plurality of shield walls; a submount having a plurality of barriers aligned with said plurality of shield walls; a plurality of transmission line pins retained within said submount and between said plurality of barriers.” Hokanson et al. fails to teach or suggest at least these features of the claimed invention.

Applicants respectfully submit that claims 2, 3, 8-10, 17, 18, and 20-26 are patentable over Hokanson et al. for at least the reason that they depend on claim 1. For at least the reasons set forth above, Applicants respectfully contend that claims 1-3, 8-10, 17, 18, and 20-26 are patentable over Hokanson et al. and request that the Examiner withdraw the present rejection of the claims under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 30-32, 37-39, 47, 49, 50, and 53-55 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hokanson et al. in view of Kuwahara et al. This rejection is respectfully traversed and reconsideration is requested.

Claim 30 is patentable over Hokanson et al. in view of Kuwahara et al. because claim 30 recites a combination of elements including, for example “a submount... including barriers between portions of adjacent transmission line pins within said cavity, wherein a surface of said barriers is coated with a conductive material.” Neither Hokanson et al. nor Kuwahara et al., singly or in combination, teach or suggest at least these features of the claimed invention.

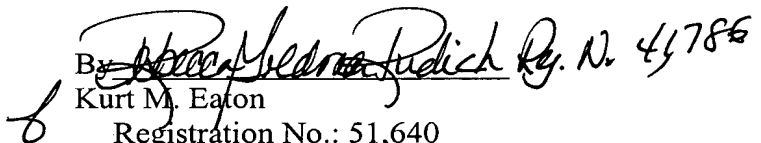
Applicants respectfully submit that claims 31, 32, 37-39, 47, 49, 50, and 53-55 are patentable over Hokanson et al. in view of Kuwahara et al. for at least the reason that they depend on claim 30. For at least the reasons set forth above, Applicants respectfully contend that claims 30-32, 37-39, 47, 49, 50, and 53-55 are patentable over Hokanson et al. in view of Kuwahara et al. and request that the Examiner withdraw the present rejection of the claims under 35 U.S.C. § 103(a).

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The Applicant hereby authorizes the Commissioner of Patents to charge any fees necessary to complete this filing, including any fees required under 37 C.F.R. §1.136 for any necessary Extension of Time to make the filing of the attached documents timely, or credit any overpayment in fees, to Deposit Account No. 50-0911. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. §1.136 for the necessary extension of time. A duplicate copy of this page is enclosed.

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Respectfully submitted,

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